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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,857	12/30/2003	Randall Cornfield	ICS-handle	6240

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EXAMINER

WILLIAMS, MARK A

ART UNIT	PAPER NUMBER
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3673

MAIL DATE	DELIVERY MODE
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10/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/748,857	Applicant(s) CORNFIELD, RANDALL	
	Examiner MARK A. WILLIAMS	Art Unit 3673	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/7/08.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 45-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herron et al., US Design Patent Des, 295,011, in view of Mosley, US Design Patent Des.397,018.

Herron provides a handle implement comprising an elongated body having a front side and a tapered rear end, top and bottom surfaces and opposing sides, said body being generally rounded and being generally parallel to a longitudinal axis at the center of said body, said tapered rear end is situated on said axis near the center of said body; a thumb positioning section situated on said top surface of said body adjacent to said front side of said body, said thumb positioning section comprising a concave indentation, said thumb positioning section sloping downwardly from said indentation towards said opposing sides of said body, said thumb positioning section comprising a thumb rest section; and an index finger rest section situated

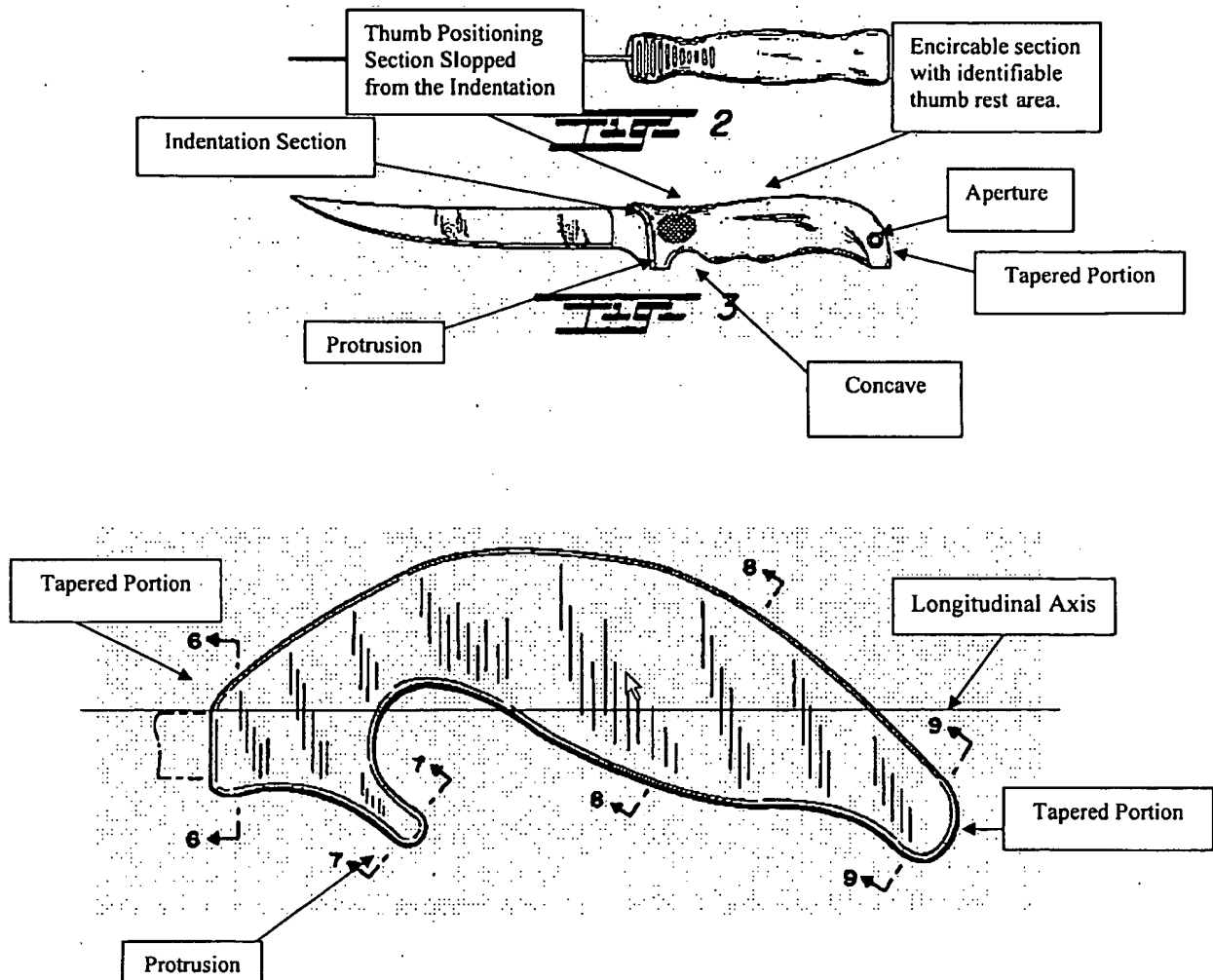
on said bottom surface of said body adjacent to said front side of said body, said index finger rest section comprising a cavity with an extended protrusion, said protrusion designed to cover at least a portion of user's index finger. An encirclable section situated adjacent said rear end of said body, said section being generally rounded in its circumference. The encirclable section is designed to support user's palms and three fingers. The thumb positioning section is situated above said index finger rest section. An aperture situated adjacent said rear end of said body. The thumb rest section is recessed relative to said thumb positioning section. The thumb rest section protrudes relative to said thumb positioning section. The tapered front and rear ends extend outwardly toward one another and then tapers adjacent said index finger rest section. The tapered front and rear ends extend outwardly toward one another and then tapers adjacent said thumb positioning section.

Herron provides the claimed invention except explicitly teaching (1) both a tapered front side and a tapered rear end, as claimed; (2) the tapered front and rear ends extend outwardly toward one another and then tapers adjacent said index finger rest section; (3) the tapered front and rear ends extend outwardly toward one another and then tapers adjacent said thumb positioning section; and (4) the thumb

rest section is constructed of a different material relative to said body and said thumb positioning section.

Regarding (1)-(3), Mosley teaches these general concepts in a particular handle design. Such a design creates a particular visual appearance that may be desired. In addition, one skilled in the art would know that the particular indentation shape provides additional shielding to the finger of a user. It would have been obvious to include such modifications in the design of Herron for the purpose of achieving a particular visual appearance of the handle as well as additional shielding means for a user's finger during use of the knife.

Regarding (4), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device in this way, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331. Such a modification would have produced no unexpected results, and is not novel. On advantage to such a modification is that such a material would add in the gripping of the device.



Response to Arguments

3. Applicant's arguments filed 7/7/08 have been fully considered but they are not persuasive.

Applicant argues that Herron does not provide the claimed front side and rear end tapers as claimed. The examiner considers Herron to provide a rear end tapered portion, but does not explicitly show a front side tapered portion, as claimed. The combination of Mosley with Herron would provide this limitation, as outlined in the above rejection.

Applicant argues that the elongated body of Herron is not provided as being generally round, as claimed. However, it is the position of the examiner that this handle body of Herron can broadly be considered as being generally rounded, because of its curved shape. (Applicant should note also that even if it were determined that Herron does not provide such a rounded shape as claimed, an obvious combination of Herron with Mosley would provide such rounded shape, clearly meeting the claimed limitations; such a modification is not considered novel and would have been obvious to one skilled in the art, as least for aesthetic appeal.)

Applicant argues that Herron does not provide a thumb positioning section with a concave indentation and the thumb positioning section sloping downwardly from the indentation towards the opposing side of the body. The examiner disagrees, since such limitations can be read in to the figure of Herron. See above

attached figure. Applicant has not sufficiently amended the claims to overcome the applied art of record.

Applicant argues that the combination does not provide an index finger rest section with a cavity and extended protrusion designed to cover at least a portion of an index finger, as claimed. However, both Herron and Mosley clearly provide such limitations. Applicant has not sufficiently amended the claims to overcome the applied art of record.

Applicant argues that the combination does not provide the body being generally parallel to the longitudinal axis of the center of the body. The examiner disagrees. The body of the resulting combination would obviously extend in a direction generally parallel to the longitudinal axis of the center of the body. Applicant has not sufficiently amended the claims to overcome the applied art of record.

Applicant argues that Herron and Mosley are not combinable because they teach away from one another. The examiner disagrees. The combination of Mosley into Herron would provide a similarly functioning handle with added features to the design producing a particular smooth, more rounded shape, that would have at least created a particular visual appeal, but not substantially modifying the function of the device. Thus the rejection is still considered proper.

Applicant argues that there is no motivation to combine Herron and Mosley as applied, and that the handles are intended to be used differently. However, it is the position of the examiner being that both handles are knife handles and intended to be used in the same applications, to borrow particular features from one handle so as to be added to the aesthetic appeal, as well as utility, of the other handle is obvious, as outlined in the above rejection. One skilled in the art may have the motivation to combine Heron and Mosley for the purpose of achieving a particular visual appearance of the handle as well as additional shielding means for a users finger during use of the knife.

Conclusion

This action is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is (571) 272-7064. The examiner can normally be reached on Monday through Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patricia L Engle/
Supervisory Patent Examiner, Art Unit 3673

/Mark Williams/
9/12/08